

REMARKS

By this amendment, Applicants amend the specification and claims 18-20, 50-52, 69, 76, 79, and 86. Claims 18-22, 50-54, 69, 76, 79, and 86 remain pending in this application.

In the Final Office Action¹, the Examiner took the following actions:

objected to the specification; and

rejected claims 18-22, 50-54, 69, 76, 79, and 86 under 35 U.S.C. § 103(a) as being unpatentable over King et al. (U.S. Patent Application Publication No. 2002/0002590) in view of Whitehouse (U.S. Patent No. 5,341,505).

I. Objection to the Specification

Applicants respectfully traverse the objection to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter. However, to expedite prosecution, Applicants have amended the specification to include further support for the claimed subject matter. Applicants submit that the amended language is supported at least by the specification and the originally-filed claims. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the objection.

II. Rejection under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 18-22, 50-54, 69, 76, 79, and 86 under 35 U.S.C. § 103(a) as being unpatentable over King in view of

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

Whitehouse. A *prima facie* case of obviousness has not been established for at least the following reasons.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements. M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)(internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Although Applicants respectfully disagree with the Examiner's interpretation of King, in an effort to expedite prosecution, Applicants have amended independent claim 18 to recite a method including, among other steps, “determining a preferred address of the user, the preferred address being one of the electronic address and the standardized physical address” and “delivering the message to the user at the preferred address.”

King discloses a system for routing emails based on the recipient's physical address. See King, Abstract. According to the King system, if a sender does not know the recipient's physical address, then the physical address can be determined by “searching based on the recipient's telephone number, zip code, state, or by any other

information that is useful in the event that the sender does not know the physical address of the recipient.” Id. at paragraph [0022]. However, King does not disclose or suggest at least “determining a preferred address of the user, the preferred address being one of the electronic address and the standardized physical address” and “delivering the message to the user at the preferred address,” as recited in amended independent claim 18.

The Final Office Action alleges that Whitehouse discloses “using a non-standardized physical address [that] includes a 5-digit ZIP code to get a standardized physical address [that] includes a 9 digit ZIP code . . . to further identify the destination address.” Final Office Action at page 3. Regardless of whether this allegation is correct, which Applicants do not concede, Whitehouse does not overcome the deficiencies of King that were discussed above. That is, Whitehouse also does not teach or suggest “determining a preferred address of the user, the preferred address being one of the electronic address and the standardized physical address” and “delivering the message to the user at the preferred address,” as recited in independent claim 18.

In view of at least the above deficiencies, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and amended claim 18. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Therefore, the Final Office Action has not clearly articulate a reason why the claim would have been obvious to one

of ordinary skill in view of the prior art and a *prima facie* case of obviousness has not been established.

Amended independent claims 50, 69, 76, 79, and 86, although of a different scope from each other and claim 18, each include recitations that are similar to claim 18. Accordingly, a *prima facie* case of obviousness has not been established for claims 50, 69, 76, 79, and 86 for at least the same reasons discussed above. Dependent claims 19-22 and 51-54 depend from one of allowable independent claims 18 and 50, and are allowable at least due to their dependence. Therefore, for at least the foregoing reasons, the Examiner should withdraw the rejection of claims 18-22, 50-54, 69, 76, 79, and 86 under 35 U.S.C. § 103(a).

CONCLUSION

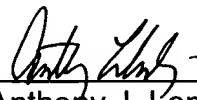
Applicants respectfully request reconsideration of the application, withdrawal of the claim rejections, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Anthony J. Lombardi
Reg. No. 53,232